



OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Gary L. Rytlewski et al.	§	Art Unit:	3672
Serial No.:	10/709,322	§		
Filed:	April 28, 2004	§	Examiner:	Daniel P. Stephenson
For:	Subsea Intervention	§		
		§	Atty. Dkt. No.:	22.1391CNT
		§		(SHL.0099C1US)

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

Claims 1, 17, and 24

It is well established law that the "PTO has the burden under section 103 to establish a *prima facie* case of obviousness[, and it] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art will lead that individual to combine the relevant teachings of the references." *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

The Office Action has clearly not satisfied its burden of establishing a *prima facie* case of obviousness. In effect, the Office Action has identified disparate elements of the prior art references, using impermissible hindsight benefiting from the teachings of the disclosure of the present invention to piece together such disparate elements. As the Federal Circuit has consistently warned, hindsight reconstruction cannot be used "to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *Id.* at 1075.

Date of Deposit:

August 2, 2006

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In the present case, the Office Action identified the frame 29 of Moss as containing the carrier line spool recited in claim 1. As conceded by the Office Action, Moss does not disclose the carrier line spool being separate from the stack. 5/4/2006 Office Action at 2. However, the Office Action cited Galerne as disclosing “that a spool in a subsea environment may be placed on the sea floor near the wellhead, and not necessarily within a stack on the wellhead.” *Id.* at 5. In making the rejection, the Office Action specifically *ignored* that the reel 39 in Galerne is for a *high-pressure hose* 25 that is located subsea. The hose 25 of Galerne is a high-pressure hydraulic hose for activating a blowout preventer. Galerne, 6:1-4. The outlet of the hose 25 is connected to the blowout preventer through a valve 31 and fitting 33. Galerne, 6:5-7. In other words, what is disclosed in Galerne is use of a reel 39 to provide a hose 25 that is attached to a blowout preventer for delivering hydraulic pressure for activating the blowout preventer. There is no suggestion whatsoever by Galerne of a carrier line spool having a carrier line, where the carrier line spool is separate from the stack adapted to operatively couple to subsea wellhead equipment, and where the stack has equipment to lower the carrier line into the subsea well. All Galerne would have suggested to a person of ordinary skill in the art is that a high-pressure hydraulic hose 25 can be attached to a blowout preventer from an underwater reel 39 for activating the blowout preventer. The high-pressure hydraulic hose 25 of Galerne is completely different from the coiled tubing/wireline 21 depicted in Fig. 2 of Moss.

Since Galerne teaches a reel 39 for a hose 25 that is connected to a blowout preventer for activating the blowout preventer, rather than a reel having a carrier line that is to be lowered into a subsea well, as recited in claim 1, Galerne clearly would not have suggested a modification of Moss to achieve the claimed subject matter.

Moreover, it is important to note that Moss clearly teaches the importance of enclosing the intervention system (including a reel 22) inside a space frame (29 in Fig. 2 of Moss) to provide structural support for the components as they are transported, deployed, retrieved, or repaired. Moss, ¶ [0019]. As further stated by Moss, the complete intervention system is run and operated with no protective enclosure required. *Id.* Thus, what Moss would have suggested to a person of ordinary skill in the art is the importance of integrating everything, including the reel for the carrier line, into a unitary frame (29 in Fig. 2 of Moss) for easier use (including transportation, deployment, retrieval, and repairing, as taught in ¶ [0019] of Moss). This specific teaching of Moss cannot be ignored when making an obviousness analysis. Each reference must

be considered in its entirety, including passages of the references that would tend to lead a person of ordinary skill in the art away from the claimed subject matter. The fact that the Examiner has ignored specific passages of the prior art references in making the obviousness rejection is a further indication that impermissible hindsight has been used.

In view of the foregoing, it is respectfully submitted that a *prima facie* case of obviousness has clearly not been established with respect to claims 1, 17, and 24.

#### Claims 15 and 29

Independent claim 15 was rejected as being obvious over Moss, Galerne, and Sonnenschein. Claim 15 recites an apparatus that has an underwater marine unit adapted to operatively couple the carrier line (part of a carrier line spool) to intervention equipment attached to subsea wellhead equipment, in response to wireless signals.

A first point of error in the obviousness rejection is that in view of the fact that no motivation or suggestion existed to combine Moss and Galerne, there also did not exist any motivation or suggestion to combine Moss, Galerne, and Sonnenschein.

The Office Action conceded that Moss in view of Galerne does not disclose an underwater marine unit adapted to operatively couple the carrier line to the intervention equipment attached to the subsea wellhead equipment in response to wireless signals.

As taught by Moss, a “standard” remote operated vehicle (ROV) is provided in which an umbilical is used for controlling an intervention system. Moss, ¶¶ [0015], [0017]. In contrast, Sonnenschein is focused on underwater wireless communications using personal devices carried by a diver. Sonnenschein, 6:24-35. Sonnenschein does mention in passing that the communications techniques for personal devices can be modified for underwater ROVs and AUVs. Sonnenschein, 13:48-56. However, there is no suggestion in this passage, or anywhere else within Sonnenschein, of modifying the teachings of Moss and Galerne to provide an underwater marine unit that operatively couples the carrier line to intervention equipment attached to subsea wellhead equipment *in response to wireless signals*. In fact, the focus of Sonnenschein is to provide a “reliable system which provides communication between *divers*, or more specifically, a paging system for transferring personal messages in a network of two or more divers.” Sonnenschein, 1:66-2:3.

Merely citing to a reference that teaches wireless communications does not satisfy the PTO's burden of establishing that a person of ordinary skill in the art would have been motivated to modify Moss and Galerne to provide the claimed subject matter, namely an underwater marine unit adapted to operatively couple the carrier line to the intervention equipment attached to the subsea wellhead equipment in response to wireless signals. Sonnenschein is completely silent on the use of wireless signals to control an ROV to operatively couple a carrier line to intervention equipment attached to subsea wellhead equipment.

Therefore, it is respectfully submitted that a *prima facie* case of obviousness has not been established with respect to claim 15.

Independent claim 29 is allowable over the cited references for similar reasons as claim 15.

#### Claim 30

Independent claim 30 was rejected as being obvious over Moss and Kogure. The Office Action conceded that Moss fails to disclose attaching one or more buoyancy tanks to at least one of the modules containing intervention equipment. 5/4/2006 Office Action at 4. However, reliance was made on Kogure as teaching this feature. *Id.*

As stated in Moss, a goal of its proposed invention is the elimination of a riser to the surface. Moss, ¶¶ [0012]-[0013]. On the other hand, Kogure is directed to a riser that includes a riser stabilizing system and supplementary buoyancy tanks fixedly positioned to the upper end of the riser 16. Kogure, 3:14-18; 3:25-26, 4:31-33. Thus, while Moss teaches the elimination of a riser, Kogure teaches the exact opposite -- a specific type of riser with equipment to support ease of use of the riser. Combining the teachings of Moss and Kogure would defeat the goals and objective of both references. A basic requirement of establishing a *prima facie* case of obviousness is that a proposed modification cannot render the prior art unsatisfactory for its intended purpose or change the principle of operation of a reference. *Id.*, § 2143.01, at 2100-137. Therefore, there can be no motivation or suggestion to combine the teachings of Kogure and Moss.

The Office Action stated that the teachings of Kogure regarding a riser and riser stabilization system can be ignored, and that "the only portion of the Kogure et al. document that needs to be considered is the buoyancy tanks." 5/4/2006 Office Action at 6. Ignoring significant

parts of the teachings of Kogure and Moss to provide the obviousness rejection based on Moss and Kogure is error. As stated by the M.P.E.P., a prior art reference "must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." M.P.E.P. § 2141.02, at 2100-132.

A person of ordinary skill in the art would have been led by Kogure to use buoyancy tanks with a riser, which is specifically at odds with the teachings of Moss regarding the elimination of a riser. Therefore, this is objective evidence that a person of ordinary skill in the art would not have been motivated to combine the teachings of Moss and Kogure in the manner proposed by the Office Action. Therefore, a *prima facie* case of obviousness has not been established with respect to claim 30.

### Conclusion

Dependent claims are allowable for at least the same reasons as corresponding independent claims. Moreover, in view of the defective obviousness rejections of base claims 1-5 over Moss and Galerne, it is respectfully submitted that the obviousness rejections of dependent claims 7, 8, 11, and 12 over Moss, Galerne, and other references have also been overcome.

Similarly, in view of the defective obviousness rejection of base claims 17 and 18 over Moss and Galerne, it is respectfully submitted that the obviousness rejection of claim 19 over Moss, Galerne, and Avakov have been overcome. Also, in view of the defective obviousness rejection of base claims 24-26 over Moss and Galerne, the obviousness rejection of dependent claim 27 over Moss, Galerne, and Kogure has been overcome.

Withdrawal of all final rejections and allowance of all claims is respectfully requested. The Commissioner is authorized to charge any additional fees and/or credit any overpayment to Deposit Account No. 20-1504 (SHL.0099C1US).

Respectfully submitted,

Date: \_\_\_\_\_

Aug 2, 2006



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